

**REMARKS**

Claims 1, 3-8, 12-13, and 18-24 have been amended. No new matter has been added. Claims 1-27 are pending.

***Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel***

Claims have been amended, and claims have been canceled, notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 1, 3-8, 12-13, and 18-24 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to “the invention” is intended to refer to the specific claim or claims being addressed herein. The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

***Claim Rejections - 35 USC § 112***

The Examiner rejected claims 19-22 under 35 USC § 112, second paragraph as indefinite because there was no antecedent basis for the element “The storage medium of claim 17.” Claims 19-22 have been amended to depend from claim 18 which provide antecedent basis for the offending phrase. Withdrawal of the rejection is solicited.

***Claim Rejections - 35 USC § 101***

The Examiner rejected claim 4 under 35 USC § 101 as directed to non-statutory subject matter. Claim 4 has been amended to recite a storage medium. Withdrawal of the rejection is solicited.

***Claim Rejections - 35 USC § 102***

The Examiner rejected claims 1-4 under 35 USC § 102(e) as anticipated by *Smith* et al. (US 6,529,956 B1). This rejection is respectfully traversed.

The fundamental principles of claim rejections under 35 USC § 102 are stated in MPEP §2131 as follows:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

“The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1 and 4 recite a method and storage media containing a printing program, respectively, for delivering printed documents. Claims 1 and 4 recite that the name and address of a destination user to receive the printed documents are entered, and an image forming apparatus is selected based on information about the destination user. Claims 1 and 4 further recite that the name and address are entered and the image forming apparatus is selected through a print driver.

*Smith* describes a document delivery system in which a sender may push a document intended for delivery to a recipient onto a server. The server typically provides a private URL to the recipient to enable the recipient to download the document. *Smith* also discloses (col. 3, lines 63-63; col. 14, lines 44-48, FIG. 18, FIG. 19) that a document may be sent to a printer, but provides no specific details of a method to deliver the printed documents.

Since *Smith* does not describe the elements of claims 1 and 4 in as complete detail as is contained in the claims, it is respectfully submitted that independent claims 1 and 4, and depending claims 2-3, are allowable. Withdrawal of the rejection is solicited.

***Claim Rejections - 35 USC § 103***

The Examiner rejected claims 5-7 and 9-11 under 35 USC § 103(a) as obvious from *Smith* in view of *Wurmfield* (US 2001/0035972 A1). Claims 8 and 12-27 have been rejected under 35 USC § 103(a) as obvious from *Smith* in view of *Wurmfield* and further in view of *Ochiai et al.* (US 7, 237,015 B1). These rejections are respectfully traversed.

In *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. \_\_\_, 127 S. Ct. 1727 (2007), the Supreme Court reiterated that claim rejections under 35 USC § 103 must be based on the analysis originally defined in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 USPQ 459 (1966). This analysis is objective:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is to be determined. (148 USPQ at 467)

The analysis required by *Graham* is discussed as length in MPEP 2141(II).

The rejections of claims 5-27 are respectfully traversed on the grounds that the Office action misinterprets the scope and content of the cited prior art and thus fails to properly ascertain the differences between the prior art and the claimed subject matter.

**Claim 5**

Independent claim 5 recites that a user to receive printed documents is identified and an image forming apparatus is selected through a window opened by a print driver. Independent claim

5 further recites that the image forming apparatus is selected based on information about the identified user and made from a search of a database that associates plural image forming apparatuses with plural users. None of these elements are taught or suggested by the references.

As previously discussed with respect to the rejection of claim 1, *Smith* merely discloses (col. 3, lines 63-63; col. 14, lines 44-48, FIG. 18, FIG. 19) that a document may be sent to a printer, but provides no specific details of a method to deliver the printed documents. *Smith* does not describe entering information through a window opened by a print driver. *Wurmfeld* and *Ochiai* do not remedy the deficiency of *Smith*.

In the rationale for the rejection of claim 5, the Office action also asserts that *Wurmfeld* discloses “selecting an image forming apparatus based upon the identified user (to receive printed documents from a print job), wherein the selection is made from a search of a database that associates plural image forming apparatuses with plural users”. This assertion misinterprets the teaching of the reference.

*Wurmfeld* discloses an adaptive interface for a digital printing system. The adaptive interface recognizes a user (sender) and, bases upon the user’s identity, self-configures into a command-responsive display tailored to the user. The display may include icons representing system resources, such as printers and scanners (i.e. image forming devices) that may be appropriate for the identified user. The system may include a database holding records for a plurality of users. Each user’s record may include identification of system resources that were previously or recently accessed by the user (Abstract, [0037]). However, *Wurmfeld* only describes displaying information identifying resources suitable for the user who is printing the documents, not for a second-party recipient who is to receive the printed documents. *Wurmfeld* does not disclose the steps of identifying a recipient/user to receive printed documents and then selecting an image forming apparatus appropriate to the recipient from the results of a search of a database associating plural recipients with plural image forming devices.

In summary, the Office action failed to properly determine the teachings of the cited references with respect to at least three limitations of claim 5, and thus failed to properly ascertain or appreciate the differences between the prior art and the claimed subject matter. It is respectfully submitted that the rejection of claim 5 under 35 USC § 103 is improper and should be withdrawn.

Claims 12 and 23

Independent claims 12 and 23 recite that information about a print job (including the name of a user to receive printed documents from the print job) is received and a network address of the user is obtained, and at least one image forming apparatus is selected, through a print driver installed on or available to the workstation or a print driver window. Independent claims 12 and 23 further recite that the image forming apparatus is selected from “a plurality of image forming apparatuses having a network address closest to the network address of the identified user”. None of these elements are taught or suggested by the references.

As previously discussed with respect to the rejection of claims 1 and 5, *Smith* merely discloses (col. 3, lines 63-63; col. 14, lines 44-48, FIG. 18, FIG. 19) that a document may be sent to a printer, but provides no specific details of a method to deliver the printed documents. *Smith* does not describe entering information through a window opened by a print driver. *Wurmfeld* and *Ochiai* do not remedy the deficiency of *Smith*.

In the rationale for the rejection of claim 12, the Office action also asserts that *Ochiai* discloses “selecting at least one of a plurality of image forming apparatuses having a network address closest to the network address of the identified user”. This assertion misinterprets the teaching of the reference. *Ochiai* describes methods for registering the physical location of devices on a network in a database. *Ochiai* further describes searching for devices from a client, but does not appear to describe selecting a device having a network address close to the network address of an identified

user who is to receive printed documents. The portions of *Ochiai* cited in the Office action are unrelated to the network addresses of the devices.

In summary, the Office action failed to properly determine the teachings of the cited references with respect to at least two limitations of claims 12 and 23, and thus failed to properly ascertain or appreciate the differences between the prior art and the claimed subject matter. It is respectfully submitted that the rejection of claim 5 under 35 USC § 103 is improper and should be withdrawn.

Claim 18

Independent claim 18 also recites that information about a print job (including the name of a user to receive printed documents from the print job) is received and a network address of the user is obtained, and at least one image forming apparatus is selected, through a print driver installed on or available to the workstation or a print driver window. This element is not taught or suggested by the references.

As previously discussed with respect to the rejection of claims 1 and 5, *Smith* merely discloses (col. 3, lines 63-63; col. 14, lines 44-48, FIG. 18, FIG. 19) that a document may be sent to a printer, but provides no specific details of a method to deliver the printed documents. *Smith* does not describe entering information through a window opened by a print driver. *Wurmfeld* and *Ochiai* do not remedy the deficiency of *Smith*.

In summary, the Office action failed to properly determine the teachings of the cited references with respect to at least one limitation of claims 18, and thus failed to properly ascertain or appreciate the differences between the prior art and the claimed subject matter. It is respectfully submitted that the rejection of claim 5 under 35 USC § 103 is improper and should be withdrawn.

Claims 7, 14, 20, 25

Claims 7, 14, 20, and 25 recite requesting and receiving confirmation of the selected image forming apparatus after the selecting step and before the directing step. The Applicant is unable to find where *Smith*, *Wurmfeld*, or *Ochiai* expressly discloses or suggests requesting and receiving confirmation of the selected image forming apparatus. Nevertheless, the Office action asserts that *Smith* discloses this element. In support of this assertion, the Office action describes that the system of *Smith* includes a notifier to handle E-mail notification to the recipient, a forwarder to forward stored items to other servers, and an e-mail scanner to determine if any e-mails were returned as undeliverable.

The basis for the rejection of claims 7, 14, 20, and 25 appears to be pure conjecture on the part of the Examiner that *Smith* requests and receives confirmation of the selected image forming apparatus simply because the system of *Smith* can send and receive e-mail. Conjecture is not an appropriate ground for rejection. Withdrawal of the rejection is solicited.

Claim 10

Claim 10 recites notifying the recipient by sending a message including information identifying the select image forming apparatus. The Office action asserts that this element is described in col. 12 of *Smith* under the heading “Transaction Management Services”. However, this portion of *Smith* merely discloses that a log of transactions may be maintained and that users may obtain various reports on transactions. This is not at all the same as notifying a recipient that documents have been sent to a selected image forming device and are waiting for pickup or printing.

*Smith* typically sends a recipient a private URL enabling the recipient to download documents in file format. In this typical case, no image forming device is selected. *Smith* also discloses that documents may be sent to a printer, but provides no details of how the printed documents reach an

intended recipient. *Smith* does not teach or suggest sending a recipient a notification that a document has been sent to a specific image forming device.

It is respectfully submitted that, since the elements of claim 10 are not taught or suggested by the reference, claim 10 is allowable. Withdrawal of the rejection is solicited.

**Claims 6, 8-9, 11, 13, 15-17, 19, 21-22, 24, and 26-27**

It is respectfully submitted that claims 6, 8-9, 11, 13, 15-17, 19, 21-22, 24, and 26-27 are allowable at least by virtue of depending from an allowable base claim. Withdrawal of the rejection is solicited.

***Conclusion***

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

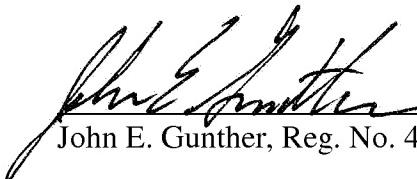
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The Examiner is invited to call the undersigned registered practitioner to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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